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JUL 8 - 1998

Paper No. 34

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicant(s): Cook et al.
Application: 07/967,267
Filed: 27 October 1992

Notice of Interference

The captioned patent application is involved in interference number 104,235. The attached appendix provides the details of the interference.

35 U.S.C. § 135(c) Notice

Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Commissioner may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six month period subsequent to the termination of the interference as between the parties to the agreement or understanding.


RICHARD TORCZON
Administrative Patent Judge

Attachment: Appendix I

All communications respecting this case should identify it by number and names of parties



Filed by: Richard Torczon
Administrative Patent Judge
Telephone: 703-308-9797
Facsimile: 703-308-7953

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
BOX INTERFERENCE
Washington, D.C. 20231

Paper No. 1

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

BRIAN SPROAT and ANGUS LAMOND,

JUL 8 - 1998

Junior Party,

v.

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

PHILLIP D. COOK, DANIEL P.C. McGEE,
and CHARLES J. GUINOSSO,

Senior Party.

Patent Interference No. 104,235

INITIAL NOTICES AND ORDER

NOTICE DECLARING INTERFERENCE

I have been designated to declare and administer this interference. 37 CFR § 1.610. Pursuant to 37 CFR § 1.611(a), I declare an interference between the captioned parties. 35 U.S.C. § 135(a).

Appendix I provides additional information required under 37 CFR § 1.611(c). A copy of Form PTO-850 and the examiner's statement is also attached. This proceeding is governed by the procedures set forth at 37 CFR § 1.601 Part 1, subpart E. The accompanying order under 37 CFR § 1.610 sets forth additional requirements specific to this proceeding.

NOTICE PURSUANT TO 35 U.S.C. § 135(c)

The parties should note the requirement to file in the Patent and Trademark Office a true copy in writing of any agreement or understanding between the parties, including collateral agreements, made with or in contemplation of the termination of this proceeding. Failure to comply with this requirement will render such agreements and any resulting patents unenforceable. See also 37 CFR § 1.690 (arbitration).

ORDER

Upon consideration of the record of this interference, I order the following:

Communications with the Board

1. All communications with me must be in writing and served on opposing counsel or must include counsel for both parties.
2. The delivery addresses for the Board of Patent Appeals and Interferences ("Board") are:

By mail: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, DC 20231

By hand: Board of Patent Appeals and Interferences
Crystal Gateway Two, 10th Floor
1225 Jefferson Davis Highway
Arlington, Virginia 22202

By facsimile: 703-308-7952

3. Conferences with me will be conducted by conference call involving both parties. Conferences must be arranged in

advance through the Board's administrators, who may be reached at 703-308-9797. Simple inquiries should be directed to the Board's administrators.

4. No party may initiate a communication with any other member of the Board regarding this interference.

Communications between the parties

5. Within 20 days of the date of this order, each party must serve a copy of its involved files on opposing counsel.

6. All papers served on opposing counsel must be served by the United States Postal Service Express Mail service, 37 CFR § 1.646(d), unless the parties agree to use a comparable (one day or better) delivery method.

Initial filings

7. Notice of receipt. Within 20 days of the date of this order, each party must file a separate paper stating when the party received the notice of declaration.

8. Notice of the lead and backup counsel. Within 20 days of the date of this order, each party must file a separate paper identifying a lead counsel and a backup lead counsel, as well as the mailing address, telephone number, and facsimile number for both lead counsel and backup counsel. 37 CFR § 1.613.

9. Notice of the real party in interest. Within 20 days of the date of this order, each party must file a separate paper identifying any right, title, or interest in any application involved in this interference. 37 CFR § 1.602.

10. Notice of other proceedings. Within 20 days of the date of this order, each party must file a separate paper identifying every related proceeding, past or present.

11. Electronic copies of the specifications and claims. Within 20 days of the date of this order, each party must file an electronic copy of each involved specification and claim.

12. Notice of copy request. Within 25 days of the date of this order each party must file a separate paper stating that the party has requested any necessary papers from the Dissemination Support Division (DSD).¹

¹ Failure to request copies very early in the proceeding may significantly delay the resolution of the interference. The Board does not provide or sell copies of interference files or the application or patent files involved in interferences. Copies may be purchased from DSD, 2183 Crystal Plaza Arcade, PTO Copy Sales Center, (703) 305-8990, Fax (703) 308-5257. DSD's mailing address is

Commissioner of Patents and Trademarks
Box 9
Washington, D.C. 20231
Attention: DSD File Copy

The DSD contact person is Teresa Knight ((703) 305-4311). Requests for copies shall not be filed with the Board unless ordered by an APJ. The parties are advised that interference files do not include the involved application or patent files. Requests for copies must specifically identify the serial number, patent number or interference number of all desired files. Because of the confidentiality provisions of 35 U.S.C. § 122 and 37 CFR §§ 1.11(e) and 1.14, requests for copies of pending applications or interference files must be accompanied with proof that the requester is authorized to have access to the files (e.g., copy of the power of attorney, power to inspect, or interference declaration, as appropriate). Failure to provide all necessary information with the request will delay obtaining copies or result in a denial of the request.

Formal requirements for filings

13. All papers filed with the Board on behalf of a party in this proceeding must include the caption shown in Appendix II.

14. Papers must have a simple descriptive title, e.g., "Sproat's Preliminary Motion No. 2". Duplicate titles are not permitted.

15. Papers must not be combined. For example, an opposition may not be combined with a motion; each must be filed separately.

16. All papers in this proceeding must be filed on A4 or 8 $\frac{1}{2}$ " x 11" paper. All filed papers must have two holes punched at the top, spaced 7 cm (2 $\frac{3}{4}$ ") apart and centered on the width of the page, for placement in the interference files.

17. Each paper filed with the Board must include a copy marked "COPY FOR THE APJ".

18. The parties may not file copies of previously filed papers. 37 CFR § 1.618(b). This prohibition extends to copies placed in appendices and exhibits.

19. Each motion or responsive paper should include an electronic copy of the filing.

20. Electronic copies should be in one of the following formats (in order of preference): WordPerfect 6.1, Microsoft Word 7.0a, Rich-text format, or ASCII. The electronic copy should be provided on a Microsoft DOS-formatted 8.9 cm (3 $\frac{1}{2}$ ") diskette.

21. Case citations must include, where available, parallel citations to a West Publishing report (e.g., Federal Reports or Federal Supplement Reports) and the Bureau of National Affairs' United States Patents Quarterly.

Filing dates

22. I will initiate a conference call with the parties to set dates for filing preliminary statements and preliminary motions and to take other appropriate action on 28 August 1998 at 1:00 p.m. (Eastern Time). See 37 CFR §§ 1.610(c), 1.621-1.628, 1.633, 1.634, and 1.637. Counsel should promptly check their calendars to determine whether this conference date will create a hardship.



RICHARD TORCZON
Administrative Patent Judge

Attachments: Two appendices
PTO-850
Checklist

APPENDIX I - 37 CFR § 1.611(c)

A. The junior party

1. Name and residence: Brian Sproat
Röntgenstraße 38
D-6900 Heidelberg
FEDERAL REPUBLIC OF GERMANY

Angus Lamond
Schillerstraße 36
D-6901 Wiesenbach
FEDERAL REPUBLIC OF GERMANY

2. Attorney or agent: FELFE & LYNCH
805 THIRD AVE
NEW YORK NY 10022

3. Assignee: Europäisches Laboratorium für
Molekularbiologie

4. Application or patent: 5,658,731, issued 19 August 1997
(08/376,697, filed 23 January 1995)

5. Accorded benefit: 07/941,078 (abandoned) (filed as
PCT/EP91/00665 on 8 April 1991)

DE P 40 11 473.2, filed 9 April 1990

B. The senior party

1. Name and residence: Phillip D. Cook
7340 BOLERO ST
CARLSBAD CA 92009

Daniel P.C. McGee
295 CHINQUAPIN AVE
CARLSBAD CA 92008

Charles J. Guinossso
313 ENCINO DR
VISTA CA 92085

2. Attorney or agent: Rebecca R. Gaumond
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS
1 LIBERTY PL 46TH FL
PHILADELPHIA PA 19103

3. Assignee: Isis Pharmaceuticals, Inc.

4. Application or patent: 07/967,267, filed 27 October 1992

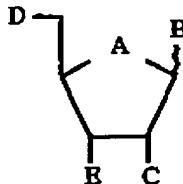
5. Accorded benefit: 07/918,362, filed 23 July 1992
(5,506,361, issued 9 April 1996) (McGee)

07/566,977, filed 13 August 1990
(abandoned) (Cook & Kawasaki)

07/463,358, filed 11 January 1990
(abandoned) (Cook & Ecker)

C. The count

(Sproat claim 1) A nucleotide of formula I,



I

wherein

B is a purine or pyrimidine base[;]

A is oxygen[;]

C is -O-R, wherein R is an alkyl group with a total of at least 2 C atom[s] or an alkenyl group or an alkynyl group having at least 2 C atoms wherein the alkyl, alkenyl or alkynyl groups are unsubstituted or substituted by at least one halogen, cyano, carboxy, hydroxy, nitro or mercapto[] group[;] and

D and E are groups selected from the group consisting of OH, -PO₄H₂, -P₂O₇H₃, -P₃O₁₀H₄, and reactive groups which form 3'-5' internucleotide bonds.

-or-

(from Cook claims 9 and 10) A compound having the structure [of formula I]

wherein

[B is guanine or 2-aminoadenine;

C is -O-R₁-(R₂)_n;

R₁ is C₁-C₂₀ alkyl, C₄-C₂₀ alkenyl, or C₂-C₂₀ alkynyl and n is an integer from 1 to 6;

R₂ is halogen, nitro, nitroso, nitrile, trifluoromethyl, trifluoromethoxy, O-alkyl, S-alkyl, NH-alkyl, N-dialkyl, O-aryl, S-aryl, NH-aryl, O-aralkyl, S-aralkyl, NH-aralkyl, imidazole, N-phthalimido, azido, hydrazino, hydroxylamino, isocyanato, sulfoxide, sulfone, sulfide, disulfide, silyl, aryl, heterocycle, carbocycle, intercalator, reporter molecule, conjugate, polyamine, polyamide, polyalkylene glycol, or polyether;

either one of [D and E] is OH, a hydroxyl blocking group, phosphate, or an activated phosphate group and the other of [D and E] is a nucleotide, or both [D and E] are nucleotides.

Corresponding claims

Sproat et al.: 1-23

Cook et al.: 9, 10, and 15-27

APPENDIX II

The following caption is required on all papers filed by a party. Bracketed material must be replaced with the indicated information.

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES
(APJ Richard Torczon)

BRIAN SPROAT and ANGUS LAMOND,
Junior Party,

v.

PHILLIP D. COOK, DANIEL P.C. McGEE,
and CHARLES J. GUINOSO,

Senior Party.

Patent Interference No. 104,235

[TITLE OF PAPER]

Filed on behalf of Party [Sproat or Cook]
By: [Name of lead counsel]
[Name of backup counsel]
[Street address]
[City, State, Zip code]
[Telephone number]
[Facsimile number]